

Docket No.: 2003P04916US01
App. No.: 10/764,233

REMARKS

Claims 1, 3-5 and 7-20 are pending in the Application. Claims 1, 5 and 16 have been amended. Claims 2 and 6 have been canceled without prejudice.

Double Patenting

The Patent Office objected to claims 16-20 as being a substantial duplicate of claims 11-15.

Applicant respectfully traverses, however claim 16 has been amended.

Claim Rejections - 35 U.S.C. § 112

The Patent Office rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Patent Office rejected claim 1 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant respectfully traverses; however, claim 1 has been amended.

Claim Rejections - 35 U.S.C. § 102

The Patent Office rejected claims 1, 3-5, 7-9 as being anticipated by U.S. Publication 2003/0174838 A1 by Bremer ("Bremer").

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Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claims 2 and 6 as being unpatentable over U.S. Publication 2003/0174838 A1 by Bremer ("Bremer").

The Patent Office rejected claims 10-20 as being unpatentable over U.S. Publication 2003/0174838 A1 by Bremer ("Bremer") in view of U.S. Patent 6,513,117 by Tarpenning et al. ("Tarpenning").

Applicant respectfully traverses each rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). Emphasis added. Additionally, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

The present application describes a novel and nonobvious system and method for maintaining media objects from a first mobile device to a second mobile device. Content protected by digital rights management mechanisms may be transferred to a second device and may only be decrypted with the specific removable data card employed with the first mobile device. Bremer and Tarpenning fail to disclose the system and method for maintaining media objects from a first mobile device to a second mobile device employing a removable data card. Content protected by digital rights management mechanisms may be transferred to a second device and may only be decrypted with the specific removable data card employed with the first mobile device. Applicant respectfully submits that claims 1, 5, 11 and

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16 recite elements which have not been disclosed, taught or suggested by Bremer and Tarpenning, individually or in combination. For example, claims 1, 5, 11 and 16 generally recite the generation of decryption information for encrypted content and storing the decryption information within a specific removable data card.

The Patent Office states that Bremer nor Tarpenning disclose transferring a specific removable data card. (Office Action of February 10, 2006, Page 8). As a result, under *Lindemann* and *In re Ryoka*, a *prima facie* case of anticipation or obviousness has not been established for claims 1, 5, 11 and 16. Consequently, claims 1, 5, 11 and 16 should be allowed. Claims 3-4, 7-10, 12-15 and 17-20 should be allowed due to their dependence upon an allowable base claim.

However, even though the Patent Office states that transferring a specific removable data card is not disclosed by Bremer nor Tarpenning, the Patent Office states it would have been obvious. The Patent Office states that it would have been obvious to "include the steps of transferring the digital rights information associated with the first mobile device to the second mobile device because it adds a flexibility for user to upgrade to a newer model of the mobile device without incurring costs to re-acquire the rights." (Office Action of February 10, 2006, Page 8). As the Examiner is well aware, Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that it would have been obvious to include the steps of transferring the digital rights information associated with the first mobile device to the second mobile device because it adds a flexibility for user to upgrade to a newer model of the mobile device without incurring costs to re-acquire the rights. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by

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the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Applicant respectfully submits that the motivation supplied for the combination is present only within the present application. The present application discloses the benefit of transferring the digital rights information associated with a first mobile device to the second mobile device through maintaining decryption information in a removable data card allowing a user to upgrade to a newer model of the mobile device without incurring costs to re-acquire the rights. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). Emphasis added. As a result, claims 1, 3-5 and 7-20 are not obvious. Claims 1, 3-5 and 7-20 should be allowed.

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Conclusion

Applicants respectfully submit that all claims are allowable, and it is respectfully requested that the entire application now be passed to formal allowance.

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Respectfully submitted,



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